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Serial no. 09/683,292  
Filed 12/10/2001  
Attorney docket no. 1044.012US1

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### REMARKS

#### Note regarding drawings

The Examiner has indicated that the drawings filed with the patent application are considered informal. Applicant disagrees, and notes that the patent application was filed electronically, which may cause the drawings to look informal as compared to patent applications that are not filed electronically, when in fact they are in formal condition. For instance, Applicant notes that margin and some other requirements of drawings as necessitated by paper filing of patent applications are inapplicable to electronically filed patent applications, since applicants are encouraged to crop drawings as closely as possible to avoid unnecessary "white space." Applicant encourages the Examiner to contact either Applicant's Attorney, or appropriate personnel with the electronic-filing division of the USPTO, for further clarification.

If the Examiner believes that the drawings are informal for reasons apart from their electronically filed nature, then Applicant requests that the Examiner identify such informalities with particularity, so that Applicant can correct them in due course. However, as it now stands, Applicant believes and asserts that the drawings are in formal condition.

#### Claim rejections under 35 USC 101

Claims 1-20 have been rejected under 35 USC 101, as being directed to non-statutory subject matter. In particular, claims 1-20 have been indicated as not being limited by language within the technological arts. The Examiner also notes that although claims should be interpreted in light of the specification's disclosure, it is generally considered improper to read limitations contained in the specification into the claims. Applicant notes first that claims 1-10 have been cancelled, rendering this rejection moot as to these claims.

Applicant has amended independent claims 11 and 16 to recite user registration "over a computer network" (e.g., over the Internet). Applicant believes that this amendment is sufficient

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to cast the claims as being directed to technological arts, and requests that the rejection under 35 USC 101 be withdrawn. Should the Examiner feel otherwise, Applicant respectfully requests that the Examiner suggest language to be included in the independent claims that would squarely place them within the auspices of the technological arts in satisfaction of 35 USC 101.

Claim rejections under 35 USC 103

Claims 1-20 have been rejected 35 USC 103(a) as being obvious over Ferguson (5,819,092). Claims 1-10 have been cancelled. Furthermore, claims 11 and 16 are independent claims, from which the remaining pending claims ultimately depend. Applicant asserts that, as amended, claims 11 and 16 are patentable over Ferguson. For at least the same reasons, the remaining pending claims are also patentable over Ferguson.

Applicant specifically discusses claim 11 as representative of claims 11 and 16 with respect to the patentability of these claims over Ferguson. That is, the amendments made to claim 11 are comparable to the amendments made to claims 11 and 16 with respect to patentability of these claims over Ferguson. Therefore, although Applicant specifically discusses the patentability claim 11 over Ferguson, Applicant submits that claim 16 is patentable for at least the same reasons, such that all the pending claims are patentable over Ferguson.

*No prima facie obviousness: Ferguson does not disclose all limitations of claimed invention*

Claim 11 has been amended so that in addition to an organization requesting and receiving a desired sub-set of personal information of the user, for which the user receives payment, a second organization also requests and receives a desired second sub-set of personal information of the user, for which the user also receives payment. Importantly, "the user is paid for access to the desired second sub-set of the personal information regarding the user *without the user having to perform any action.*" That is, the user registers with the information provider, such that the personal information regarding the user is stored by the information provider. With respect to the

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user receiving payment by the *second* organization requesting and receiving the desired second sub-set of the user's personal information, *the user does not perform any action in response to which the second organization pays the user*. A sub-set of the personal information of the user is accessed by the second organization, and the user is paid by the second organization without having to do anything.

By comparison, Ferguson explicitly discloses the user only being paid in response to performing an action. "[T]he online service may pay the user for performing some type of *action*, such as winning a contest or completing a marketing survey." (Col. 3, ll. 44-46; see also col. 4, ll. 62-64, and col. 30, ll. 60-67) Thus, in Ferguson, the user is paid only when he or she performs an action. If the user completes a marketing survey, the user is paid, or if the user wins a contest, the user is paid. Ferguson does not disclose, suggest, or teach the user being paid further even where the user has not performed any action, in contradistinction to the claimed invention. Furthermore, there is no motivation to modify Ferguson so that the user is paid even where he or she has not performed any action. For example, say the user completes a marketing survey. The user is paid for completing the survey, in response to performance of the user's action. Why would the user be paid *additional sums of money*, when the user has already completed the survey? This does not make sense.

By comparison, the claimed invention is limited to, when the second organization receives a sub-set of the information, the user being paid, even though the user has not performed any action in response to which the payment has been paid. That is, the user is paid each time any organization receives a sub-set of his or her personal information, *without the user performing any action*. Therefore, Ferguson does not suggest, teach, disclose, or otherwise render obvious the claimed invention. Ferguson is limited to user payment in response to actions being performed by the user. The claimed invention is specifically limited to user payment the second time around where the user has not performed any action. The pending claims are thus patentable

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over Ferguson, because Ferguson does not teach all the elements of the claimed invention, such that there is no *prima facie* obviousness of the claimed invention relative to Ferguson.

*No prima facie obviousness: Ferguson does not teach invention as a whole*

Applicant further reminds the Examiner that “[i]n determining the differences between the prior art and the claims, the question under 35 USC 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious.” (MPEP sec. 2141.02) (Citations omitted) Analysis of Ferguson against the claimed invention as a whole, however, demonstrates that Ferguson does not render the invention as a whole obvious.

For example, Ferguson discusses fees levied and paid to content providers and users, period. However, the claimed invention as a whole is limited to users being paid for specific access to the personal information of these users. Even if Ferguson could possibly be said to contain all of the individual parts of the claimed invention, the claimed invention as a whole is not taught by Ferguson. Ferguson simply does not teach the invention of a user providing personal information; an organization accessing that personal information; and, the user being paid for such access. Therefore, there is no *prima facie* obviousness of the claimed invention relative to Ferguson.

*Rebuttal of prima facie obviousness: secondary considerations*

Applicant asserts that even if Ferguson renders the claimed invention *prima facie* obvious, secondary considerations exist that nevertheless render the claimed invention non-obvious patentable. Evidence of non-obviousness include the following Graham v. John Deere Co., 381 US 1 (1966), factors, as the Examiner is likely aware: fulfillment of long-felt need; failure of others; copying by others; and, unexpected results. Applicant specifically notes that the invention

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provides for the fulfillment of a long-felt need within the industry, and that this secondary consideration weighs in favor of patentability.

In particular, advertising on the Internet and in other mediums is considered intrusive. Users are bombarded by ads throughout their daily life. Advertisers, however, have to bombard people with ads because the advertising is not targeted. That is, the advertisers do not know which people will be receiving which ads, so they have to fill all possible channels with advertisements in the hope that the desired individuals will receive the ads, even if this group represents only a small part of the population that receives the ads overall.

The solution to this problem within the prior art has been targeted advertising. Advertisers attempt to gain as much information about specific users as possible, typically clandestinely and surreptitiously, and then show only certain users certain ads. For example, on the Internet, there are ways for advertisers to learn the geographic areas of users when they are browsing the Internet, so that the advertisers can serve different ads to users in different geographic areas. As another example, search engines like Google serve ads based on the keywords that the users are searching by, and further have proposed an email service in which users' emails are scanned, and ads are served based on the content of these emails.

The problem with these targeted advertising approaches has been that an invasion of privacy backlash has occurred. Users are concerned that more and more organizations are clandestinely and surreptitiously tracking their every move, especially over the Internet, and using their information in ways that the users have not authorized. More and more users are employing special types of computer programs when browsing the Internet, for instance, so that their identities are better cloaked.

Advertisers have thus become frustrated. The long-felt need is thus that advertisers need to target users as best as possible, but without running afoul of privacy concerns of users that can spur additional backlashes. The claimed invention solves this long-felt need. In particular, the claimed invention has the advertisers and other organizations *paying* the users in exchange for

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their personal information, which may then be used by the advertisers to target the users in advertising campaigns, and so on. Privacy concerns are not run afoul, because the users are authorizing access to their personal information in exchange for payment. Thus, no privacy backlashes can likely occur by use of the invention. Advertisers are happy, because they are able to better target their advertising to receptive users.

Therefore, even if the claimed invention is considered *prima facie* obvious over Ferguson, the fulfillment of this *Graham v. John Deer* secondary consideration, long-felt need, renders the claimed invention non-obvious and patentable.

#### Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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